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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,975	10/10/2002	Melanie Ann Pykett	025069-00001	9572
4372	7590	12/17/2003	EXAMINER	
ARENT FOX KINTNER PLOTKIN & KAHN 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			YU, GINA C	
		ART UNIT		PAPER NUMBER
		1617		/6
DATE MAILED: 12/17/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/069,975	PYKETT ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Gina C. Yu	1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-10 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) 1-10 is/are rejected.  
 7) Claim(s) \_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.  
 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.  
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.  
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1</u> . | 6) <input type="checkbox"/> Other: ____ .                                   |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1, 2, and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Ogawa et al. (US 5658578) ("Ogawa").

Ogawa discloses a composition comprising 0.1 % by weight of magnesium ascorbic acid phosphate, 0.1 % by weight of vitamin E (tocopherol), and 0.01 % by weight of panax ginseng extract. See Example 9; col. 2, lines 11-17. The reference teaches using 0.005-10 % of ginseng extract, preferably 0.01-10 % by weight. See col. 2, lines 5 – 10. See instant claims 5 and 6. The "synergistic" effect of the composition is inherently present.

2. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Chen (US 6524626 B2).

Chen discloses a composition comprising 1% of ascorbic acid, 1 % of tocopheryl acetate, and 5 % by weight of ginseng (panax ginseng). See Examples 9. See also Examples 13, 22. See instant claims 1-5. Example 13 discloses 2 % of grape seed extract, 1 % of tocopheryl acetate, and 1 % of ascorbic acid. See instant claims 1-5. The “synergistic” effect of the composition is inherently present.

3. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Gubernick (US 6066327).

Gubernick discloses an antioxidant mixture comprising 2 % by weight of tocopheryl acetate, 0.2 % by weight of magnesium ascorbyl phosphate, and 0.1 % by weight of rosemaryl extract. See Example; instant claims 1, 2, 4-6. See col. 3, lines 39 – 40 for instant claim 3. The “synergistic” effect of the composition is inherently present.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen as applied to claims 1-5 above, and further in view of Gubernick (US 6066327).

Chen teaches a composition comprising panax ginseng and morus alba leaf (mulberry). While the reference illustrates other formulas comprising ascorbic acid and generally teaches to combine herbal and plant ingredients to provide various vitamins, the reference fails to specifically mention the component (c).

Gubernick teaches that rosemary extract is a well-known antioxidant in cosmetic art, used in the amount of 0.0001-1 % by weight. See col. 4, lines 1-20. The reference also teaches using 0.01-20 % by weight of magnesium ascorbyl phosphate. See col. 3, lines 41 – 50; Example.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of Chen by adding rosemary extract as motivated by Gubernick because of the expectation of successfully producing a cosmetic composition with enhanced antioxidant property.

2. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gubernick applied to claims 1-6 above, and further in view of Maybeck (US 5164182).

Gubernick, discussed above, teaches that the antioxidant mixture is useful in treating and preventing the symptoms of photoaging such as blotches, pigmented spots. See col. 1, lines 15 –53.

While Gubernick teaches that the invention is applicable in formulating cosmetic compositions, such as a therapeutic product and used in combination with other actives, the reference fails to specifically mention *morus alba*.

Maybeck, as discussed above, teaches using mulberry extract as a skin-lightening and anti-inflammatory agent. See instant claim 7. The reference teaches using dry mulberry extract in the amount ranging from 0.005-1 wt %, most preferably 0.005-0.1 wt %. See col. 4, line 16. See instant claims 8 (b) -10 (b).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Gubernick by adding mulberry extract as motivated by Gubernick and Maybeck because of the expectation of successfully producing an anti-aging cosmetic composition with skin lightening and anti-inflammatory effects.

#### ***Double Patenting***

Claims 1-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 10/030147. Although the conflicting claims are not identical, they are not patentably distinct from each other because each sets of claims are directed to compositions comprising three antioxidants selected from the same species within the overlapping weight range.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina Yu  
Patent Examiner

  
SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER

12/15/03